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SEP 14 2009

In re Patent No. 7,535,457	:	
Lincoln Eramo	:	OFFICE OF PETITIONS
Issue Date: May 19, 2009	:	
Application No. 10/767,986	:	DECISION ON REQUEST FOR
Filed: January 29, 2004	:	RECONSIDERATION OF
Attorney Dkt. No. S63.2-11325-	:	PATENT TERM ADJUSTMENT
US01	:	
Title: Lubricious Composition	:	

This is in response to the "Application for Patent Term Adjustment" filed July 20, 2009. This petition is properly treated under 37 CFR 1.705(d). Patentee requests that the patent term adjustment be corrected to show an adjustment of 1099.

The request for reconsideration of patent term adjustment is **DISMISSED**.

On May 19, 2009, the above-identified application matured into US Patent No. 7,534,495 with a patent term adjustment of 683 days. This request for reconsideration of patent term adjustment (including the required fee) was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

Patentee requests recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that pursuant to Wyeth, a PTO delay under 35 U.S.C. §154(b)(1)(A) overlaps with a delay under 35 U.S.C. §154(b)(1)(B) only if the delays "occur on the same day." Patentee maintains that a portion of the period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), 416 of the 511 days, does not overlap with the 766 day period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a), as these periods do not occur on the same day. Thus, patentee requests

that the determination of patent term adjustment be increased from 416 days to 1099 days.

Patentee submits that the total period of adjustment for Office delay is the sum of the period of three-year delay (511 days) and the period of examination delay (766 days) to the extent that these periods of delay are not overlapping. As such, patentee asserts entitlement to a patent term adjustment of 1099 days (511 days plus 766 days less 95 days of overlap less 83 days of applicant delay).

The Office finds that as of the filing of the request for continued examination (RCE) on June 23, 2008, the application was pending three years and 511 days after its filing date. An entry of a period of adjustment of 766 days was entered for Office delay. Further, an undisputed reduction of 83 days for applicant's failure to engage in reasonable efforts to conclude prosecution was taken. At issue is whether patentees should accrue an additional 511 days of patent term adjustment for the Office taking in excess of three years to issue the patent as well as 766 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that 511 days overlap. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent

term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

As such, the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames. In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the filing date January 29, 2004 until the filing of the RCE on June 23, 2008. Prior to the issuance of the patent, 766 days attributable to the Office's failure to issue a first Office action no later than fourteen months after the application filing date were entered.

The Office did not delay 766 days and then delay an additional 511 days. Accordingly, 766 days of patent term adjustment for Office delay (not 511 days and 766 days) was properly entered

because the entire period of delay of 511 days attributable to the delay in the issuance of the patent under 37 CFR 1.702(b) overlaps with the 766 days attributable to grounds specified in § 1.702(a)(1). Further, patentees failed to engage by an uncontested period of 83 days.

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent was 683 days (766-83).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Charlema Grant, Petitions Attorney, at (571) 272-3215.

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